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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,543	05/26/2000	Beatrice Gaugler	LUD 5353.5 (10016355)	7364

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EXAMINER

HARRIS, ALANA M

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 11/18/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/579,543

Applicant(s)

GAUGLER ET AL.

Examiner

Alana M. Harris, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 38-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 38-66 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 22-36) in Paper No. 13, received April 17, 2002 is acknowledged. The traversal is on the ground(s) that the nucleic acid, SEQ ID NO: 14 of Group II encodes the same protein as the nucleic acids, SEQ ID NO: 13 and 15 of Group I. This is found unpersuasive.

SEQ ID NO: 14 is not 100% homologous to SEQ ID NO: 13, nor SEQ ID NO: 15 as evidenced by the attached database sheets. Given that (a) SEQ ID NO: 13 and SEQ ID NO: 15 are named MAGE-4 and SEQ ID NO: 14 is termed MAGE-41, (b) there are differences in the nucleic acid residues and (c) there is no pointedly expressed information in the specification that MAGE-4 and MAGE-41 are one in the same there is no assurance that these nucleic acids encode the same proteins. Hence, the restriction is proper and SEQ ID NO: 14 is regarded as a patentably distinct product.

2. Claims 38-66 are pending.

Claims 38-41, 43, 44, 58-60, 64 and 66 have been amended.

Claims 38-66 have been added.

Claims 33-37 have been canceled.

Claims 38-66 are examined on the merits.

***Priority***

3. It is of record in the continuing data CIP 07/764,364, now U.S. Patent 5,327,252.

This application and its respective patent are not commensurate with the instant application. Patent '252 is a print evaluation apparatus. Applicants are requested to correct the continuity data in the first line of the specification so that it reflects the proper application, U.S. 07/764,365 (filed September 23, 1991), now abandoned.

***Oath/Declaration***

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying the instant application by the proper application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it references an application patent number that is not relevant to the instant application. U.S. Application number 07/764,364 should be replaced with U.S. Application number 07/764,365, which is now abandoned. Applicants should update the status of all priority documents listed on the declaration.

***Drawings***

5. The drawings are objected to because of reasons cited on attached form PTO 948 completed by draftsman. Correction is required.

***Claim Objections***

6. Claims 38-41, 43-45, 58-61, 64 and 66 objected to because of the following informality: these claims reference non-elected sequence, SEQ ID NO: 14.

Subsequently, claims 42, 46-57, 62-63 and 65 depending from the said claims have also been objected. Correction is required.

***Sequence Compliance***

7. This application contains sequence disclosures on page 35, lines 15, 16, 32 and 34; page 36, line 24 that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). This application fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

8. Claims 38-66 are free of the art.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (703) 306-5880. The examiner can normally be reached on 6:30 am to 4:00 pm, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 308-4315 for regular communications and (703) 308-4315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

**ALANA HARRIS**  
**PATENT EXAMINER**

*Alana Harris*  
Alana M. Harris, Ph.D.  
November 18, 2002